

U.S. Patent Application No. 09/996,516
Amendment dated May 9, 2005
Reply to Office Action dated November 17, 2004

REMARKS/ARGUMENTS

Claims 1 - 29 are pending in the above-identified application. Claims 1 - 13, 15, 17, 28 and 29 are withdrawn from consideration.

Reconsideration and continued examination of this application are respectfully requested. The applicants have amended the claims so that claim 14 is an independent claim and so that the enzyme composition of claim 18 comprises a protease, esterase or lipase. Full support for the amendments can be found throughout the present application as originally filed, including the claims. For instance, see pages 7-9 of the present application. Also, U.S. Patent No. 5,356,800, incorporated by reference at page 7 recites a protease enzyme. Accordingly, no questions of new matter should arise. It is respectfully submitted that the claim amendments put the claims in condition for allowance and do not require further consideration and/or an additional search. Entry of the amendments to the claims is therefore respectfully requested.

Rejection of Claims 16, 18 - 24, 26, and 27 under 35 U.S.C. §103(a) over Sarkar et al.

At page 2 of the Office Action, the Examiner rejected claims 16, 18-24, 26, and 27 under 35 U.S.C. §103(a) as being unpatentable over Sarkar et al. (U.S. Patent No. 5,501,770). The Examiner alleged that Sarkar et al. describes a process for making paper in which a cellulytic enzyme is added to papermaking sludge and recycled to be incorporated with the papermaking stock. The Examiner then alleged that the sludge normally contains substances such as rosin and starch, which are well known sizing agents. Thus, the Examiner concluded that one skilled in the art would expect improved sizing using the process of Sarkar et al. since allegedly the same papermaking sludge is treated with the same cellulytic enzyme. The Examiner indicated that claims 14 and 25 would be

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allowable if rewritten in independent form. Additionally, at the bottom of page 2 of the Office Action, the Examiner alleged that Sarkar et al., at column 2, lines 46-54, describes treating the previously unused clarified sludge for re-use in papermaking. Thus, the Examiner took the position that Sarkar et al. inherently includes the addition of the treated sludge to the pulp furnish in order to re-use the sludge and make paper. For the following reasons, this rejection is respectfully traversed.

Independent claim 18 is amended to specify that the enzyme composition comprises at least one of a protease, an esterase or a lipase. Support for this amendment may be found, for example at page 8, lines 1 - 4 and in U.S. Patent No. 5,356,800 (as mentioned above), wherein a protease is mentioned, and at page 8, line 13 to page 9, line 12, wherein esterases and lipases are mentioned. It is respectfully submitted that claim 18 is allowable over Sarkar et al. on at least the same grounds that the Examiner indicated that claim 25, which provides that the enzyme composition is a lipase, is allowable. In particular, Sarkar et al. mentions only cellulolytic enzymes and contains absolutely no teaching or suggestion of proteases, esterases, or lipases. Moreover, claims 23 and 24, which provide that the enzyme composition has cellulytic activity or cellulytic and hemicellulytic activity, respectively, are allowable since they depend from allowable claim 18 and require at least one of a protease, an esterase, or a lipase. Moreover, claim 14, which the Examiner indicated is allowable, is rewritten in independent form. Accordingly, claims 14, 16, and 18 - 27 are allowable, and the rejection of claims 16, 18-24, 26, and 27 under 35 U.S.C. §103(a) over Sarkar et al. should be withdrawn.

Withdrawn claims

Upon allowance of elected claims 14, 16, and 18 - 27, the Examiner is requested to

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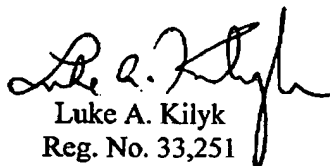
telephone the undersigned to discuss cancellation of withdrawn claims 1 - 13, 15, 17, 28, and 29
by Examiner's Amendment.

CONCLUSION

In view of the foregoing remarks, the applicants respectfully request reconsideration of
this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge
the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37
C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged
to said Deposit Account.

Respectfully submitted,


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